

**REMARKS****Paragraph 1 of the Office Action**

Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent  
5 form for failing to further limit the subject matter of a previous claim.

Claim 11 has been cancelled.

Withdrawal of the objection is respectfully requested by the applicant.

**Paragraphs 2, 3 and 6 of the Office Action**

10 Claims 1, 2, 6, 7 and 10-15 are rejected under 35 U.S.C. §103(a) as being  
unpatentable over U.S. Patent Number 2,697,460 to Barnett in view of U.S. Patent  
Number 4,416,372 to Polk. Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being  
unpatentable over Barnett in view of Polk, as applied to claims 1, 2, 6 and 7 above and  
further in view of U.S. Patent Number 5,632,374 to Fitzsimmons et al.

15 Claims 8 and 9 have been cancelled.

The limitations of claim 8 have been included into newly amended claim 1. In  
particular, claim 1, and claim 16, each include the limitation that the first housing has  
slots therein that are staggered with respect to the slots in the second housing when the  
first and second housings are placed in a closed position. This serves an important  
20 function for the applicant's device, which is not addressed and cannot be anticipated in  
the prior art. In particular, the applicant's device stores a plurality of saw blades in a  
manner that allows for their easy retrieval, but also, and more importantly, prevents  
damage to the blades while they are being stored. The blades, being comprised of a  
metal, are generally not in danger of being damaged by the housing itself. The greatest  
25 danger of damage to the blades is if they strike or rub against each other while they are  
being stored. The staggered slots prevent this from happening by interspersing the blades  
in the first housing with the blades in the second housing.

It is respectfully submitted to the Examiner that Fitzsimmons cannot teach nor  
anticipate this type of staggering since Fitzsimmons only teaches the staggering of slots  
30 within just one support and therefore these slots are staggered with respect to themselves  
only, not staggered with respect to slots in a second housing. A pair of housings having

the Fitzsimmons' structure would still lead to the discs of such a device striking each other as there is no teaching within the references that the applicant's manner of staggering is advantageous or warranted. For this reason, claims 1, 16 and all claims that depend from claim 1 cannot be anticipated by combination are believed to be in condition  
5 for allowance.

It is further submitted to the Examiner that the combination of Barnett and Polk is not obvious and the combination does not form the applicant's claimed structure. While the Examiner has cited *Graham*, that case has been added to over the years to include the requirement of motivation. The law is clear that obviousness is not established by what  
10 could be done, but instead what would be done when one is presented with the prior art, in a vacuum, and without the benefit of the applicant's specification. This is achieved through the requirement of motivation, which must be supplied by the prior art itself and cannot be gleaned from the applicant's specification.

15 [E]very element of a claimed invention may often be found in the prior art. See *id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.  
20 See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

25 *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). It is evident that nearly any application for a patent would be denied patentability were an Examiner allowed to simply pick and choose elements from prior art references, absent motivation, as nearly all inventions are combinations of known elements. However, the law does not allow this type of piecemeal construction to occur and it is this type of construction that has presently take place. The Examiner, in this case, has found a structure containing two housings, Barnett, and simply combined it with slots found in Polk. But simply finding  
30 slots is not enough, there must be motivation to combine the slots with Barnett and that motivation must come from the prior art. To what purpose would Barnett require the slots? In fact, since the Barnett device is used as a workbench, see Figure 3, the chests F and G are inverted and anything in the slots would simply fall out. It is for that reason that Barnett includes covers 142 for chests F and G. Slots would prevent the Barnett

device from working properly and therefore instead of motivation to make the combination, there is support against this type of combination.

With respect to claim 6, the Examiner has stated that the housings are spaced from each other. However, the Examiner had already stated that "Barnett also discloses a

5 first housing having a bottom side (*Fig 2 reference letter G*)...; (and) a second housing (*Fig 2 reference letter F*)..." which are each hingedly coupled to a panel. (emphasis added). Figure 1 clearly shows that these elements, G and F, are touching each other and that there is no space between them. The area, referenced by the Examiner with respect to the legs, is a space that is not part of the housings. Further, as shown in Figure 3,

10 chests F and G are not even attached to the panel but are simply sitting in pockets formed by outer walls 42, 43, 44 and brackets 148. For the above reasons, not only is there no motivation to make the combination as supplied by the Examiner, the combination does not form the applicant's claimed structure and claim 6 is believed to be in condition for allowance.

15 Withdrawal of the rejection is respectfully requested by the applicant.

#### Paragraph 4 of the Office Action

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of Polk, as applied to claim 1 above and further in view of U.S. Patent Number

20 5,782,356 to Hugg.

As indicated above, Barnett does not teach spaced or attached housings and therefore any combination using Barnett as the primary reference must be deficient in the claimed limitations of the applicant's device. However, it is respectfully submitted to the Examiner that with respect to claim 3, there is no motivation to first use slots with

25 Barnett, and second there is no motivation to angle the slots of Polk. The first point was expanded above. As to the second point, there can be no motivation to angle the slots of Polk, as this would only decrease the number of slots available to Polk. Further, the Polk device is configured to hold dry wall blades with the handle 30 extending upwardly from the slots. Angled slots would cause the side walls of the case 10 to abut one of the

30 handles and to angle the handles with respect to each other. This would make it more difficult to grip the handles and more difficult to put the blades into and extend them

from the case 10. Therefore, the combination as suggested by the Examiner counters the advantages of Polk and therefore cannot be anticipated by Polk and Hugg.

The applicant respectfully requests withdrawal of the rejection.

5 **Paragraph 5 of the Office Action**

Claims 4 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of Polk, as applied to claims 1 and 2 above and further in view of U.S. Patent Number 5,193,680 to Schumann.

The applicant accepts the proposition that Schumann teaches an aperture  
10 extending through a housing. However, that still does not provide any motivation to make the combination. As stated above, Barnett does not include slots. But even if Barnett did include slots, there is nothing within the prior art references to suggest that blades would be placed in the Barnett slots and therefore there would be no reason to extend an opening through Barnett device that could be axially aligned with the blades.  
15 Therefore, it is believed that claims 4 and 5 cannot be anticipated by the combination as put forth by the Examiner.

The applicant respectfully requests withdrawal of the rejection.

**Paragraph 7 of the Office Action**

20 Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Barnett in view of Polk, U.S. Patent Number 5,782,356 to Hugg, Schumann and Fritsimmons et al.

For each of the reasons above, claim 16 is believed to be in condition for allowance.

25 Withdrawal of the rejection is respectfully requested by the applicant.

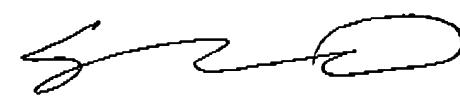
CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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